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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,206	12/05/2003	Bruce C. Campbell	86924CPK	9475

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EXAMINER

SCHWARTZ, PAMELA R

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,206

Applicant(s)

CAMPBELL ET AL.

Examiner

Pamela R. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 3, 6-14 and 25-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5 and 15-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/9/05 and 12/5/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-24, drawn to an ink jet recording element, classified in class 428, subclass 32.1.
 - II. Claims 25-26, drawn to a printing process, classified in class 347, subclass 105.
 - III. Claims 27-28, drawn to a method of making, classified in class 427, subclass 331.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and of Group II are related as product and process of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a materially different method such as the method of writing with an ink pen.

Inventions of Group III and of Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by a materially different method such as forming the ink receiving layer on a casting surface, subjecting the surface to plasma treatment, and adhering this treated

layer to one or more other layers including a substrate and an intermediate adhesive layer.

Inventions of Group II and of Group III are the process of using and the process of making the same article. They are patentably distinct from each other because the article is patentably distinct from each method as set forth above.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: ink jet recording elements with independent and distinct porous image receiving layers. Applicants were asked to elect an ultimate species for the image receiving layer.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 15-24 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Mr. Konkol on May 25, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-24 and the species of image receiving layer that is a polyester open-cell voided film (claims 1, 2, 4, 5, and 15-24). Affirmation of this election must be made by applicant in replying to this Office action. Claims 3, 6-14 and 25-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention or species.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 5, 15, 17-21, 23 and 24 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Anagnostopoulous et al. (2003/0082353).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The reference a process for making an ink jet recording element. The reference discloses that substrate materials known in the art include polyethylene coated paper and ink receiving layers that contain mordant to immobilize dye [0008]. Additionally, the reference discloses that it is known in prior art media to include an anticurl layer [0028]. The reference discloses forming an open cell voided surface layer which may be of polyester through a process including plasma treatment of the surface [0044-0045]. The reference also discloses that a polymer containing mordant may form the surface of the ink receiving layer [0049-0050]. The support may be polyethylene coated paper [0046]. Figure 3 discloses the cell walls support on a layer of swellable polymer (i.e. an

intermediate ink-permeable base layer between the support and the image-receiving layer. Missell et al., which has been incorporated by reference, disclose substrates of polyethylene terephthalate, and that swellable base layers may be formed from polyester (6,045,917 col. 5, lines 30-44 and col. 6, lines 1-16).

While the reference with its incorporated materials is believed to fully disclosed the invention as set forth in the above referenced claims, it would also have been obvious from the disclosure of the reference concerning the inventive concept and conventional aspects of ink jet recording materials to form an ink jet recording element with conventional support, backing and swellable layers and including the open cell structure disclosed therein.

The surface of the porous image receiving layer as set forth by the reference should inherently meet the requirement of instant claim 1 to 40% elemental carbon at the surface of the layer prior to plasma treatment.

3. Claims 1, 2, 4, 5, and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Iida et al. (2003/0118790). The reference discloses an ink jet recording paper including a porous resin film that is 30 to 90% thermoplastic resin and 1 to 70% fine inorganic or organic powder [0053]. The thermoplastic resin may be polyethylene terephthalate [0055]. To form pores, the powder is select so that it is non-compatible with the resin [0078]. The porous film may be part of a laminate including paper or thermoplastic resin [0090]. Pores may be formed by orienting the film [0094]. The porous film may be laminated to a base material which may include non-hydrophilic thermoplastic resin [0100]. Such resin was earlier disclosed as including polyester

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[0055]. The base material may include 15 to 60% fine inorganic or organic powder (i.e. voiding agent) [0102]. The porous resin film is subjected to an oxidation treatment such as plasma treatment [0106-0107]. An ink fixative may be included in an ink-receiving layer on the surface of the porous resin film [0134]. The porous resin film is also considered to be an image receiving layer since it will receive any dye that is not captured in the ink-receiving layer.

The surface of the porous resin film as set forth by the reference should inherently meet the requirement of instant claim 1 to 40% elemental carbon at the surface of the layer prior to plasma treatment.

4. Claims 1 and 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iida et al. (2003/0118790) alone or in view of applicants' admissions concerning the state of the art. See in particular the first paragraph on page 9 of applicants' specification as well as prior art materials incorporated by reference. The primary reference discloses that the porous resin film disclosed therein may be laminated to other materials including thermoplastic film and paper laminate. Additionally, the reference discloses that a base material layer may be a resin filled with inorganic or organic powder [0100-0102]. The base material layers and laminates disclosed by applicants are conventional in the art, including an anticurl or antistat layer, a voided base layer and resin coated paper substrates. Therefore, it would have been obvious to one of ordinary skill in the art to include these additional layers in the medium of the primary reference for their conventional functions in the art.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
May 31, 2005



PAMELA R. SCHWARTZ
PRIMARY EXAMINER